

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAJ N. MISRA, JAGABANDHU DAS,
STEVEN E. HALL, WEN-CHING HAN,
PHILIP M. SHER
and PHILIP D. STEIN

Appeal No. 94-0820
Application 07/772,830¹

ON BRIEF

Before SOFOCLEOUS, JOHN D. SMITH and ELLIS, **Administrative Patent Judges.**

ELLIS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 19, all the claims pending in the application.

Claims 1, 8 and 19 are illustrative of the subject matter on appeal and are attached as an appendix to this decision.

¹ Application for patent filed October 7, 1991.

Appeal No. 94-0820
Application 07/772,830

The references relied on by the examiner are:

Ohtani et al. (Ohtani)	5,043,451	Aug. 27, 1991
Jones et al. (Jones)	5,077,309	Dec. 31, 1991
Misra et al. (Misra)	5,100,889	Mar. 31, 1992

Claims 1 through 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Misra in view of Ohtani.

Claims 1 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Misra in view of Jones.²

We have carefully considered the respective positions of the appellants and the examiner and find ourselves in substantial agreement with that of the appellants. Accordingly, we **reverse** both rejections for the reasons set forth in the Brief.

According to the examiner:

The claimed compounds differ solely from those of Misra in the specific cyclic moiety $R_3-C-C-R_4$ bridging the two claims. Misra has a 7-oxa bicycloheptyl moiety. The claims recite numerous rings including bornane, norbornane, bicyclooctane and cycloalkyl. The secondary references, in

² We note that the Answer contains a typographical error in the statement of the rejection. Answer, p. 2. The examiner has inadvertently stated that claims 1-9 are rejected over Misra in view of Jones, rather than claims 1-19. However, it is apparent from the final Office action (Paper No. 6) that the examiner intends the rejection to include all the claims. It is also apparent from their Brief, that the appellants understood the rejection to encompass all the claims. Brief, pp. 1 and 3. Accordingly, for purposes of this appeal, we have considered the issues as they apply to claims 1-19.

Appeal No. 94-0820
Application 07/772,830

analogous compounds teach numerous ring system [sic, systems] including that of Misra and the claims. It would be [sic, would have been] obvious to one skilled [sic, one of ordinary skill] in the art to substitute the ring system of Misra with one of the prior art and obtain the desired results {Answer, para. bridging pp. 2-3}.

We find the examiner's position untenable.

As we understand the rejection, the examiner is urging that the $R_3-C-C-R_4$ moiety of the claimed compound is merely a "bridge" and, therefore, its presence does not affect the biological properties of the compound. However, in reviewing the references, we do not find any teachings with respect to the referenced moiety acting a "bridge," nor have any such teachings been pointed out by the examiner. Thus, it is difficult for us to discern on what basis the examiner reached his conclusion. Accordingly, on this record, we find that the examiner has not established, through the use of factual evidence, or sound scientific reasoning, that the combined limitations would have been obvious to one of ordinary skill in the art at the time the application was filed. A conclusion of obviousness must be based on facts, and not unsupported generalities. **In re Freed**, 425 F.2d 785, 788, 165 USPQ 570, 572 (CCPA 1970); **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

Appeal No. 94-0820
Application 07/772,830

The decision of the examiner is reversed.

REVERSED

MICHAEL SOFOCLEOUS)	
Administrative Patent Judge)	
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)	
JOHN D. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOAN ELLIS)	
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Appeal No. 94-0820
Application 07/772,830

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Appeal No. 94-0820
Application 07/772,830

APPENDIX